

NAKAJIMA - 09/786,208
Attorney Docket: 007874-0277852

REMARKS

Claims 1-11, 40, 41, 46, 47 and 52-96 are pending. By this Amendment, claims 12-35, 38, 42, 43, 45, 48, 49 and 51 are canceled without prejudice or disclaimer; claims 1-11, 40, 41, 46 and 47 are amended; and claims 52-96 are added. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Claims 1-4, 11, 17, 22, 25, 31, 33, 35 and 38 were rejected under 35 U.S.C. §112, second paragraph. The rejection is respectfully traversed.

Claims 17, 22, 25, 31, 33, 35 and 38 have been canceled without prejudice or disclaimer, thus rendering moot the rejection with respect to these claims.

The Office Action on page 2 alleges that the claims are generally narrative and indefinite, failing to conform with current U.S. practice. The Office Action further alleges that the claims are replete with grammatical and idiomatic errors. The Office Action concludes that the claims fail to clearly convey what Applicant intends to be his invention due to their vague and indefinite wording. Applicant respectfully disagrees.

With respect to claims 1 and 2, the Office Action alleges that "the concept" of synchronization is unclear and concludes that Applicant's use of the terms "synchronization" and "synchronizing" are intended to be some form of authentication of the billing and paying terminals to each other. Applicant respectfully disagrees and respectfully submits that the Examiner's reliance on page 4 of the specification in the conclusion that "synchronization" and "synchronizing" are a form of authentication is improper.

It is respectfully submitted that Applicant is using the terms "synchronization" and "synchronizing" (and any other variation of the root word "synchronize") as they would be understood by one of ordinary skill in the art. Applicant respectfully notes that the term "synchronization" is subject to various meanings. Although not intending to be limited to any particular definition, it is respectfully submitted that the terms "synchronization" and "synchronizing" may be interpreted according to any of the definitions, depending on the context in which they are used. It is also respectfully submitted that it is unfair to present Applicant with a plurality of definitions for the term "synchronization" and require that he "pick one" for purposes of examination. Applicant is using the term "synchronization" as it would be understood by those of ordinary skill in the art. In some instances and/or contexts, the term may be interpreted as meaning the matching of timing between elements of the claimed invention, whereas in other instances/contexts it may be interpreted as meaning the coordination of communications between elements of the claimed invention.

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For example, as disclosed on page 23, lines 6-13, the synchronizing server 30 acquires information about the billing of a commodity transaction by communication to the cashier terminal, acquires information about the paying of a commodity transaction by communication to the user terminal 20, and processes the settlement in transactions between the cashier terminal 10 and the user terminal by synchronizing the communication to the cashier terminal 10 with the communication to the user terminal.

As another example, as disclosed on page 23, line 26 through page 24, line 2, a "synchronizing settlement" is a method that does not directly communicate between the cashier terminal 10 and the user terminal 20, but rather processes a transaction settlement between the cashier terminal 10 and the user terminal 20, by synchronizing communication in real-time between the cashier terminal 10 and the user terminal 20 via the synchronizing server 30 which communicates with both the cashier terminal 10 and the user terminal 20.

Further examples of the term "synchronizing" are found throughout the specification, such as in the description of the "synchronizing authorization" on page 25, lines 9-23, and the combination of the "synchronizing settlement" with the "synchronizing authentication" on page 27, lines 27 through page 28, line 5.

It is respectfully submitted that it is clear from the examples discussed above that the first and second terminals communicate with each other via the transaction apparatus and one of the terminals controls or instructs the other terminal, respectively.

With respect to the Examiner's concern that the specification shows no reference to a clock or timing pulse, it is respectfully submitted that such concern is misplaced. Firstly, the Examiner's concern is not applicable to the issue of whether the claims particularly point out and distinctly claim the subject matter that Applicant regards as his invention. Applicant does not regard his invention to be limited by a clock or a timing pulse. Secondly, although the Examiner's concern may be relevant under 35 U.S.C. § 112, 1st paragraph, it is respectfully submitted that Applicant is not required to disclose a clock or a timing pulse. As acknowledged by the Examiner, such features are understood in computer engineering. As permitted, and encouraged by MPEP § 2164.01, Applicant has omitted this well-known feature from the specification. See, also, MPEP § 2106C. Such omission, however, has no bearing on the issue of whether the claims particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

With respect to claims 3 and 4, it is respectfully submitted that the Examiner is improperly attempting to distill the claimed invention to its "gist" or "thrust," which is

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contrary to PTO policy as set forth in MPEP § 2141.02. It is respectfully noted that claims 3 and 4 do not include the term "authentication." It is respectfully submitted that it is clear that Applicant is not using the terms "synchronization" and "synchronizing" synonymously or interchangeably with the terms "authentication" and "authenticating."

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph are respectfully requested.

Claims 1-10, 40, 41, 46 and 47 were rejected under 35 U.S.C. §103(a) over Takayama (U.S. Patent 6,332,133) in view Stein et al. (U.S. Patent 5,826,241). The rejection is respectfully traversed.

Claim 1 recites a transaction system for transacting through a communication network including, *inter alia*, a first terminal connecting to the communication network having an information indicating unit. A second terminal having a unique ID information and an input unit is located at a same site as the first terminal and connectable to the first terminal through the communication network. A transaction apparatus communicates with the first and second terminals through the communication network. The transaction apparatus previously stores the unique ID information of the second terminal and sets up a transaction ID information to be indicated on the indicating unit of the first terminal. The transaction apparatus receives from the second terminal the unique ID information of the second terminal together with the transaction ID information indicated on the information indicating of the first terminal and inputted through the input unit of the second terminal at the same site as the first terminal. The transaction apparatus performs a transaction by synchronizing a communication with the first terminal and a second terminal when the unique ID information received from the second terminal is identical with that stored in the transaction apparatus previously.

As discussed above, the first and second terminals are located at the same site. Neither Takayama nor Stein et al. disclose or suggest this features. In addition, as also discussed above, the transaction apparatus identifies the second terminal by both the unique ID and a transaction ID. The transaction ID information is set up by the transaction apparatus to be indicated on the indicating unit of the first terminal. The transaction apparatus receives from the second terminal the unique ID information of the second terminal together with the transaction ID information indicated on the information indicating unit of the first terminal and inputted through the input unit of the second terminal at the same site as the first terminal. If the two kinds of information from the second terminal are identical with the unique ID stored previously and transaction ID information set up by the transaction

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apparatus shortly before, the synchronization between the first and second terminals can be performed.

There is no disclosure or suggestion by either Takayama or Stein et al. of transferring the transaction ID information from the first terminal to the second terminal located at the same site. Takayama merely disclose a settlement system having a billing terminal and a paying terminal, but does not disclose or suggest setting up a transaction ID information to be indicated on an indicating unit of a first terminal. It is also respectfully submitted that Stein et al. fail to cure this deficiency of Takayama as Stein et al. merely disclose a transaction identifier 142 generated by the front program 190.

As the combination of Takayama and Stein et al. fails to include all the limitations of claims 1, the combination fails to present a *prima facie* case of obviousness.

Claims 2, 40, 46 and 52-61 and new claims 62-66, 77-74 and 77-96 recite addition features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Claim 3 recites a transaction apparatus for transacting to a communication network where a first terminal and second terminal having unique ID information. The transaction apparatus includes a user data base for previously storing the unique ID information of the second terminal. A processing unit sets a transaction ID information to be indicated on the first terminal. A first communication unit is provided for connecting to the first terminal via a first communication network and the first communication unit since the transaction ID information to be indicated on the first terminal to the first terminal. A second communication unit is provided for connecting to the second terminal via a second communication network and receives from the second terminal the unique ID information of the second terminal together with the transaction ID information that is indicated on the first terminal and inputted through the second terminal at a same site as the first terminal. The processing unit performs the transaction by synchronizing a communication with the first terminal and the second terminal when the unique ID information received from the second terminal is identical with that stored in the user data base.

As discussed above, there is no disclosure or suggestion by either Takayama or Stein et al. of a first terminal and second terminal at the same site. There is also no disclosure or suggestion by either Takayama or Stein et al. of receiving from the second terminal the unique ID information of the second terminal together with the transaction ID information that is indicated on the first and inputted through the second terminal at the same site. As

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neither Takayama nor Stein et al. disclose or suggest, at least, these features, the combination fails to present a *prima facie* case of obviousness.

Claims 4-11, 41, 47, 67-71, 75 and 76 recite additional features of the invention and are allowable for the same reasons discussed above with respect claim 3 and for the additional features recited therein.

With respect to the taking of Official Notice for claims 5-7, it is respectfully submitted that the taking of Official Notice fails to cure the deficiencies of the combination of Takayama and Stein et al. discussed above with respect to claim 3. It is further respectfully submitted that the taking of Official Notice with respect to these claims is again an improper attempt by the Examiner to reduce the claimed invention to its thrust or gist. For example, with respect to claim 5, Applicant is not claiming the use of a checksum. With respect to claims 6 and 7, it is respectfully noted that the claims recite a first terminal data base storing information about the first terminal, wherein the first communication unit receives from the first terminal an identifying number to identify the first terminal. The processing unit retrieves the information about the first terminal from the first terminal data base and confirms the registration of the first terminal, based on the identifying number. Although the Office Action alleges that the use of unique identification of financial terminal and confirmation through such identification is old and well-known in the financial art, the Office Action fails to account for the claimed first communication unit that receives the identifying number and a processing unit that retrieves the information about the first terminal from the data base and confirms the registration.

In accordance with MPEP §2144.03, the Examiner is respectfully requested to provide documentary evidence for each and every instance of the taking of Official Notice to support the conclusion that the features recited in claims 5-7 are considered to be common knowledge or well-known in the art. In the absence of such documentary evidence, it is respectfully submitted that the rejections must be withdrawn.

Claims 11, 12, and 17-21 were rejected under 35 U.S.C. §103(a) over Takayama in view of Stein et al. and further in view of Foster et al. (U.S. Patent 6,332,134). The rejection is respectfully traversed.

Claims 12 and 17-21 have been canceled, thus rendering moot their rejection.

With respect to claim 11, it is respectfully noted that Foster et al. has a U.S. filing date under 35 U.S.C. §102(e) of March 9, 2000 and claims priority to a provisional application filed November 1, 1999. Even assuming that all the subject matter of Foster et al. was

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disclosed in the provisional application, Foster et al. will only have effective U.S. filing date of November 1, 1999.

The instant application is the national phase of PCT/JP99/04178, filed August 2, 1999. Accordingly, Applicant has established a date of invention of, at the latest, August 2, 1999, which is prior to Foster's earliest filing date of November 1, 1999. Accordingly, Foster et al. is not prior art.

Reconsideration and withdrawal of the rejection of claim 11 are respectfully requested.

Claims 22-24, 32, 33, 38, 42, 43, 45, 48, 49 and 51 were rejected under 35 U.S.C. §103(a) over Takayama in view of Stein et al. and further in view of Heath, Jr. (U.S. Patent 5,321,242). These claims have been canceled, thus rendering moot their rejection.

Claims 25-31, 34 and 35 were rejected under 35 U.S.C. §103(a) over Takayama in view of Stein et al., Heath, Jr., and Foster et al. These claims have been canceled, thus rendering moot their rejection. In addition, as discussed above, Foster et al. is not prior art.

Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Application 09/630,557. The rejection is respectfully traversed.

MPEP §804II.B.1 sets forth the criteria for establishing a *prima facie* case of obviousness-type double patenting. This section of the MPEP clearly states the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a rejection under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness-type double patenting, the differences between the inventions defined by the conflicting claims must be identified and the reasons why a person of ordinary skill in the art would conclude the invention defined in the claim in issue is an obviousness variation of the invention defined in a claim in the patent or application must be established.

Claim 1 recites a transaction apparatus communicating with the first second terminals through a communication network and previously storing a unique ID information of the second terminal. The transaction apparatus sets up a transaction ID information to be indicated on the indicating unit of the first terminal and the transaction apparatus received from the second terminal the unique ID information of the second terminal together with the transaction ID information indicated on the first terminal and inputted through the input unit of the second terminal at the same site as the first terminal.

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Claim 1 of U.S. Application 09/630,557 does not include any of these features. It is also respectfully submitted that these features would not have been obvious to one of ordinary skill in the art. It is further respectfully noted that when considering whether the invention defined by claim 1 of the instant application is an obvious variation of the invention defined in claim 1 of U.S. Application 09/630,557, the disclosure of U.S. Application 09/63,557 may not be used as prior art.

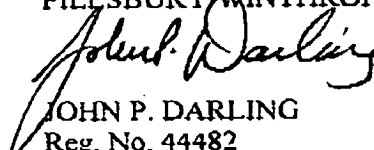
Reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Date: August 16, 2005

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